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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,938	06/26/2001	David Finn	70128	5330

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EXAMINER

TREMBLAY, MARK STEPHEN

ART UNIT

PAPER NUMBER

2827

DATE MAILED: 03/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/830,938

Applicant(s)

FINN ET AL.

Examiner

Mark Tremblay

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 17-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-32 is/are rejected.
- 7) ☒ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Applicant: Finn et al.

Filing date: 10/28/99

***Claim Rejections - 35 USC § 112***

5           Claim 27 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Re claim 27, "the clear surface" has no antecedent basis.

10                           ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

15           (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

20           Claims 17, are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent #5,557,096 to Watanabe et al. ("Watanabe" hereinafter). Watanabe teaches an identification label with a transponder unit for surface mounting on or mounting around an object, the label having a multi layered structure comprising:

an identification layer 2 for optical marking (see figure 1);

a reinforcement layer 46 (see column 11) for mechanical stabilization of the identification layer, said reinforcement layer forming a substrate with the transponder unit 51 arranged thereon; and

25           an adhesion layer for mounting the identification label on the object (see column 11, lines 62-64).

***Claim Rejections - 35 USC § 103***

30           The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

5 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10 This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

15 Claims 18-32, are rejected under 35 U.S.C. § 103 as being unpatentable over Watanabe. Watanabe teaches the features of the invention as described above, but fails to teach certain of the features in the dependent claims.

20 Re claims 18-20, 26, Watanabe teaches layers comprising at least 217, where 217 clearly provides a boundary between the upper layers and the adhesive layer. The reinforcement layer for preventing stress is not shown in these figures. The adhesive layer for fixing the label to packages is not shown in other figures. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the adhesive layer, including a boundary layer 217 between the adhesive layer and the other layers, with the reinforcing layer, 25 because this would provide both the ability to affix the label to packages and to resist any bending stresses that may be created in the affixing of the label to the package or any subsequent stresses. The adhesive layer is also covered with a deadening layer 218.

30 Re claim 21, a window or aperture is inherently provided in the layers for accepting the circuit, since it is embedded in the layers, and cannot occupy the same space at the same time as the layers.

Re claim 22, see figure 66a.

Re claims 24-25, the antenna in numerous embodiments is positioned on the

reinforcement layer, and the adhesive covers the bottom side, forming a plane adhesion surface.

Re claim 29, Watanabe teaches a carrier layer 218a.

5 The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U. S. Patent #5,153,842 to Dlugos, Sr. et al. showing another transponder unit which may be adhesively affixed to a package.

*Allowable Subject Matter*

10 Claim 27 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

15 The following is a statement of reasons for the indication of allowable subject matter: while stacked sheets with intervening separator or deadening layers are well known in the art, this claim provides for using the clear surface of one base unit as the deadening layer of another unit. Only improper hindsight would allow the examiner to combine all the elements of the prior art to meet the limitations of this claim.

*Voice*

20 Inquiries for the Examiner should be directed to Mark Tremblay at (703) 305-5176. The Examiner's regular office hours are 10:30 am to 7:00 pm EST Monday to Friday. Voice mail is available. If Applicant has trouble contacting the Examiner, the Supervisory Patent Examiner, Michael Lee, can be reached on (703) 305-3503. Technical questions and comments concerning  
25 PTO procedures may be directed to the Patent Assistance Center hotline at 1-800-786-9199 or (703) 308-4357.

  
**MARK TREMBLAY**  
PRIMARY EXAMINER

30 March 19, 2003